



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|---------------------|------------------|
| 10/562,910 | 03/29/2006 | Hans Brekle | R.305588 | 3842 |
| 2119 | 7590 | 05/22/2009 | EXAMINER | |
| RONALD E. GREIGG | | | COLEMAN, KEITH A | |
| GREIGG & GREIGG P.L.L.C. | | | ART UNIT | |
| 1423 POWHATAN STREET, UNIT ONE | | | PAPER NUMBER | |
| ALEXANDRIA, VA 22314 | | | 3747 | |
| MAIL DATE | | DELIVERY MODE | | |
| 05/22/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,910

Applicant(s)

BREKLE, HANS

Examiner

KEITH COLEMAN

Art Unit

3747

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-20 and 24-28 is/are allowed.
- 6) ☒ Claim(s) 12-14, 21-23 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-14, 21-23, and 29-31 are rejected under 35 U.S.C. 102 (b) as being anticipated by Dombek ET al. (US Patent No. 5,542,827).

With regards to claim 12, the patent to Dombek et al. discloses a pressure-holding valve (22) for a fuel injection system including at least one fuel valve device having a high-pressure region (52) and a low-pressure region (i.e. portion of 52 near end 48), the valve comprising a valve housing (i.e. housing 40) having a first connection (i.e. portion connected to cap 46) connectable to the low-pressure region and a second connection (82) connectable to the return of a fuel injection valve device (32, See Figure 1), a reciprocating valve cup (64) contained in the valve housing (40), a first spring device (62) prestressing the valve cup (64), a through opening (i.e. the bottom opening of 64) in the valve cup (64), a closing element (70) operable to close the through opening (See Figure 2); a second spring device (68) applying a prestressing force to the closing element (70) in order to maintain a minimum pressure in the return, and a pressure relief device (49) contained in the valve housing (40) between the first connection and the valve cup (64), the pressure relief device (49) being operable from outside the valve housing (See Figure 2).

With regards to claim 13, the patent to Dombek et al. discloses wherein the pressure relief device comprises a pressure pin (49) that protrudes from the first connection (See Figure2) toward the valve cup (64).

With regards to claim 14, the patent to Dombek et al. discloses wherein the pressure relief device comprises a positioning disk (78) clamped between the second spring device (68) and the valve housing (64), the pressure pin (49) protruding from the positioning disc (78).

With regards to claim 31, the patent to Dombek et al. discloses a fuel injection system including a low-pressure region and a high-pressure region from which a fuel injection valve device is supplied, which fuel injection device is connected to the low-pressure region via a return, and a pressure-holding valve connected to the return of the fuel injection valve device and to the low-pressure region, the pressure holding valve comprising a valve housing having a first connection connectable to the low-pressure region and a second connection connectable to the return of a fuel injection valve device, a reciprocating valve cup contained in the valve housing, a first spring device prestressing the valve cup, a through opening in the valve cup a closing element operable to close the through opening; and a second spring device applying a prestressing force to the closing element in order to maintain a minimum pressure in the return, and a pressure relief device contained in the valve housing between the first connection and the valve cup, the pressure relief device being operable from outside the valve housing (See Rejections for Claims 12-14).

With regards to claim 29, the patent to Dombek et al. discloses an arbor (i.e. the screw mechanism 49) on the inside of the tool, the arbor extending from the bottom in the direction of the longitudinal tool axis, the arbor having an outer diameter slightly smaller than the inner diameter of the first connection and having a length greater than the length of the first connection (See Figures 2 and 3).

With regards to claims 21-23 and 30, the patent to Dombek et al. discloses a tool, wherein the tool comprises a cup-shaped base body with a bottom wall and an essentially circular, cylindrical circumferential sidewall extending from the bottom wall, the inner diameter of the sidewall being slightly greater than the diameter of the outer circumference of the pressure-holding valve in the region of the first connection (See Figure 2).

Allowable Subject Matter

Claims 15-20 and 24-28 are allowed.

Applicant's Arguments

Applicant has included items numbers for claims 12-31 and further rewrote 15 in independent form. Applicant further contends that the 102 rejection does not hold since the Applicant's invention operates differently and does not disclose a valve mechanism.

Examiner's Response to Arguments

Applicant simply elides over the actual claim language. Using broadest reasonable interpretation, valve is clearly defined as “any device for halting or controlling the flow of a liquid, gas, or other material through a passage, pipe, inlet, outlet, etc.” and Dombek et al. explicitly states on Col. 2, Lines 15-25 that “To assure that the priming pump 22 creates only a one way flow of fuel toward the transfer pump 20, one-way check valves 24 are disposed each side of the pump to maintain the direction of fuel flow.” The claims clearly states comprising or having other components.

Furthermore, the specificity found in Applicant’s remarks and specification is not found in the claimed language. Applicant is reminded to see MPEP 2111. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” Thus, the claim is not limited to such interpretation and the rejection still holds.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Nakajima (US Patent Publication 2002/0083080) shows the current state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH COLEMAN whose telephone number is (571)270-3516. The examiner can normally be reached on 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Cronin can be reached on (571)272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAC
/Keith Coleman/
Examiner, Art Unit 3747

/Mahmoud Gimie/
Primary Examiner, Art Unit 3747